

ESTTA Tracking number: **ESTTA461550**

Filing date: **03/13/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	NetApp, Inc.
Granted to Date of previous extension	03/14/2012
Address	495 East Java Drive Sunnyvale, CA 94089 UNITED STATES
Attorney information	Rochelle D. Alpert Morgan, Lewis & Bockius LLP One Market, Spear Street Tower San Francisco, CA 94105 UNITED STATES ralpert@morganlewis.com, lweinberg@morganlewis.com, sfrademarks@morganlewis.com Phone:415-442-1326

Applicant Information

Application No	85355876	Publication date	11/15/2011
Opposition Filing Date	03/13/2012	Opposition Period Ends	03/14/2012
Applicant	Appneta, Inc. 110 Cedar Street, Suite 100 Wellesley, MA 02481 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2011/04/26 First Use In Commerce: 2011/04/26 All goods and services in the class are opposed, namely: Network performance diagnostics and analysis software
Class 042. First Use: 2011/04/26 First Use In Commerce: 2011/04/26 All goods and services in the class are opposed, namely: Consulting services in the field of computer network performance diagnostics, analysis and optimization

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2844772	Application Date	01/09/2003
Registration Date	05/25/2004	Foreign Priority	NONE

		Date	
Word Mark	NETAPP		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 File servers dedicated to perform a single function and dedicated computer hardware and operating software; computer hardware and software for storing, managing, replicating, transferring, securing, retrieving and restoring data and files; computer hardware and software for sharing, updating, partitioning, and accessing common files over a computer network; computer hardware and software for optimizing the accessibility, delivery, backup, security, restoration and replication of data; computer hardware and software for managing, monitoring and securing networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks; and downloadable computer software for use in troubleshooting computer hardware and software problems</p> <p>Class 041. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 Educational services, namely, arranging and conducting online and instructor-led training courses, lectures, classes, workshops, seminars and conferences in the fields of computers, computer software and hardware, computer storage networks, computer storage devices, data and computer file storage, management, replication, security, retrieval, restoration and distribution, and management, monitoring and security of computer networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks; and distribution of course materials in connection therewith; providing educational testing to determine professional skills in the fields of computers, computer software and hardware, computer storage networks, computer storage devices, data and computer file storage, management, replication, security, retrieval, restoration and distribution, and management, monitoring and security of computer networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks</p> <p>Class 042. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 Technical support services, namely, monitoring and troubleshooting for problems with computers, computer software and hardware and computer storage networks, and providing back-up computer programs and facilities</p>		

U.S. Registration No.	2088731	Application Date	01/19/1996
Registration Date	08/19/1997	Foreign Priority Date	NONE
Word Mark	NETAPP		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 file servers dedicated to perform a single function and dedicated computer hardware and operating software and instructional and user manuals sold therewith</p>		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	Common law rights in the identified marks.
Goods/Services	See attached Notice of Opposition.

Attachments	NOTICE OF OPPOSITION (Exhibits A-B).pdf (16 pages)(633589 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/LEW/
Name	Leigha E. Weinberg
Date	03/13/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 85/355,876
Filed June 24, 2011
For the mark **APPNETA**
Published in the OFFICIAL GAZETTE on November 15, 2011

NETAPP, INC., a Delaware corporation,

Opposer,

v.

APPNETA, INC., a Delaware corporation,

Applicant.

Opposition No.:

NOTICE OF OPPOSITION

NetApp, Inc., a Delaware corporation, having its principal place of business at 495 East Java Drive, Sunnyvale, California 94089 (“NetApp”), believes that it will be damaged by the registration of the mark shown in Serial No. 85/355,876 and hereby opposes same.

As grounds for the opposition, NetApp alleges as follows:

1. NetApp, a publicly traded company, offers and sells computer hardware and software products and services for storage and data management, and the delivery of data and content on demand across computer networks. NetApp has long developed, marketed and offered its enterprise data management products and services, including hardware and software for storing, backing-up, securing and managing data, and data and storage resource management.
2. NetApp, under its NETAPP[®] mark and trade name, offers, among other goods and services, computer software and hardware for managing, monitoring and securing databases and storage devices across computer networks and services related thereto. NetApp

has used the NETAPP[®] mark and name since at least as early as September 1, 1995. Through its continuous use of its NETAPP[®] mark and name in connection with its varied products and services, the NETAPP[®] mark and name have come to identify NetApp, its quality products and services, and its goodwill.

3. NetApp's products sold under the NETAPP[®] mark and name have long been used by a wide variety of enterprises in a wide range of industries. In 2011 alone, NetApp achieved \$5.1 billion in revenue through sales of its products and services.

4. NetApp promotes its products and services under the NETAPP[®] mark and operates an Internet website using the domain name "netapp.com," which prominently features the NETAPP[®] mark, as do virtually all of its marketing and promotional materials, user guides and products.

5. Through substantial investment of time and effort, NetApp has built extensive good will and recognition for its NETAPP[®] mark and name.

6. NetApp is the owner of, among other NETAPP[®] registrations, United States Registration No. 2,844,772 for the mark NETAPP[®] for "file servers dedicated to perform a single function and dedicated computer hardware and operating software; computer hardware and software for storing, managing, replicating, transferring, securing, retrieving and restoring data and files; computer hardware and software for sharing, updating, partitioning, and accessing common files over a computer network; computer hardware and software for optimizing the accessibility, delivery, backup, security, restoration and replication of data; computer hardware and software for managing, monitoring and securing networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks; and downloadable computer software for use in troubleshooting computer hardware and software

problems” in International Class 9, “[e]ducational services, namely, arranging and conducting online and instructor-led training courses, lectures, classes, workshops, seminars and conferences in the fields of computers, computer software and hardware, computer storage networks, computer storage devices, data and computer file storage, management, replication, security, retrieval, restoration and distribution, and management, monitoring and security of computer networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks; and distribution of course materials in connection therewith; providing educational testing to determine professional skills in the fields of computers, computer software and hardware, computer storage networks, computer storage devices, data and computer file storage, management, replication, security, retrieval, restoration and distribution, and management, monitoring and security of computer networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks” in International Class 41; and “[t]echnical support services, namely, monitoring and troubleshooting for problems with computers, computer software and hardware and computer storage networks, and providing back-up computer programs and facilities” in International Class 42. This registration issued on May 25, 2004, and became incontestable with the filing (and acceptance) of NetApp’s Section 8 and 15 affidavits demonstrating continuous use of the NETAPP® mark for five years after registration. A true and correct copy of the TARR and Assign Status pages for this mark from the USPTO web site are attached hereto as Exhibit A.

7. NetApp is the owner of United States Trademark Registration No. 2,088,731 for the mark NETAPP® for “file servers dedicated to perform a single function; related computer hardware and software and instructional and user manuals sold therewith” in International Class 9. This registration issued on August 19, 1997, became incontestable with

the filing (and acceptance) of NetApp's Section 8 and 15 affidavits demonstrating continuous use of the NETAPP® mark for five years after registration, and has been timely renewed. A true and correct copy of the TARR and Assign Status pages for this mark from the USPTO web site are attached hereto as Exhibit B.

8. By application number 85/355,876, Applicant seeks to register the mark APPNETA for "Network performance diagnostics and analysis software" in International Class 9 and "Consulting services in the field of computer network performance diagnostics, analysis and optimization" in International Class 42. The opposed application was filed on June 24, 2011, years after NetApp's NETAPP® registrations were registered and became incontestable for NetApp's products and services.

**FIRST GROUND FOR OPPOSITION
(Likelihood of Confusion)**

9. NetApp realleges the allegations contained in paragraphs 1 through 8 of this Notice of Opposition as if fully set out herein.

10. The designation for which Applicants seek registration — APPNETA — is confusingly similar in sight, sound, and meaning to NetApp's well-known NETAPP® mark and name.

11. On information and belief, NetApp alleges that the products and services for which Applicant seeks to register the opposed APPNETA designation are related to and/or complementary to NetApp's products and services. Moreover, on information and belief, NetApp alleges that Applicant directs its products and services offered under the confusingly similar APPNETA designation to the same and/or overlapping consumers that use NetApp's products and services or to whom NetApp promotes and offers its products and services bearing its NETAPP® marks. Further, on information and belief, NetApp alleges that Applicant and

NetApp use the same or overlapping channels of trade to target the same or overlapping prospective customers.

12. Inasmuch as NetApp's NETAPP[®] mark and name and Applicant's applied-for APPNETA designation are confusingly similar, will be used for related, if not competitive, products and services, and are offered through the same or overlapping channels of trade to the same or overlapping purchasers and users, Applicant's proposed mark is likely to cause confusion, or to cause mistake, or to deceive or disparage by falsely suggesting a connection with or otherwise damaging NetApp.

WHEREFORE, NetApp requests that application Serial No. 85/355,876 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of NetApp.

Dated: March 13, 2012

Respectfully submitted,

By: /s/ Leigha E. Weinberg
Leigha E. Weinberg
Attorney for Opposer NetApp, Inc.

Rochelle D. Alpert
Leigha E. Weinberg
Morgan, Lewis & Bockius LLP
One Market, Spear Street Tower
San Francisco, CA 94105
Telephone: (415) 442-1326
Facsimile: (415) 442-1001
Email: ralpert@morganlewis.com
lweinberg@morganlewis.com

EXHIBIT A

TO NOTICE OF OPPOSITION

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-03-13 15:43:45 ET

Serial Number: 78201846 Assignment Information Trademark Document Retrieval

Registration Number: 2844772

Mark (words only): NETAPP

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2010-06-04

Filing Date: 2003-01-09

Transformed into a National Application: No

Registration Date: 2004-05-25

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: L60 -TMEG Law Office 106

Date In Location: 2010-06-04

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. NETAPP, INC.

Address:

NETAPP, INC.
495 EAST JAVA DRIVE
SUNNYVALE, CA 94089
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

File servers dedicated to perform a single function and dedicated computer hardware and operating software; computer hardware and software for storing, managing, replicating, transferring, securing, retrieving and restoring data and files; computer hardware and software for sharing, updating, partitioning, and accessing

common files over a computer network; computer hardware and software for optimizing the accessibility, delivery, backup, security, restoration and replication of data; computer hardware and software for managing, monitoring and securing networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks; and downloadable computer software for use in troubleshooting computer hardware and software problems

Basis: 1(a)

First Use Date: 1995-09-01

First Use in Commerce Date: 1995-09-01

International Class: 041

Class Status: Active

Educational services, namely, arranging and conducting online and instructor-led training courses, lectures, classes, workshops, seminars and conferences in the fields of computers, computer software and hardware, computer storage networks, computer storage devices, data and computer file storage, management, replication, security, retrieval, restoration and distribution, and management, monitoring and security of computer networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks; and distribution of course materials in connection therewith; providing educational testing to determine professional skills in the fields of computers, computer software and hardware, computer storage networks, computer storage devices, data and computer file storage, management, replication, security, retrieval, restoration and distribution, and management, monitoring and security of computer networks, computer disc drives, electronic data storage systems, databases and other storage devices across computer networks

Basis: 1(a)

First Use Date: 1995-09-01

First Use in Commerce Date: 1995-09-01

International Class: 042

Class Status: Active

Technical support services, namely, monitoring and troubleshooting for problems with computers, computer software and hardware and computer storage networks, and providing back-up computer programs and facilities

Basis: 1(a)

First Use Date: 1995-09-01

First Use in Commerce Date: 1995-09-01

ADDITIONAL INFORMATION

Prior Registration Number(s):

2088731

2565475

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-06-04 - Section 8 (6-year) accepted & Section 15 acknowledged

2010-06-04 - Case Assigned To Post Registration Paralegal

2010-05-20 - TEAS Section 8 & 15 Received

2008-06-25 - Automatic Update Of Assignment Of Ownership

2004-05-25 - Registered - Principal Register

2003-11-21 - Extension Of Time To Oppose Received

2003-10-07 - Published for opposition

2003-09-17 - Notice of publication

2003-08-05 - Approved for Pub - Principal Register (Initial exam)

2003-06-26 - Examiners amendment e-mailed

2003-06-23 - Assigned To Examiner

2003-05-07 - TEAS Change Of Correspondence Received

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Rochelle D. Alpert

Correspondent

Rochelle D. Alpert
MORGAN, LEWIS & BOCKIUS LLP
ONE MARKET, SPEAR STREET TOWER
SAN FRANCISCO CA 94105
Phone Number: 415-442-1326
Fax Number: 415-442-1001

**United States Patent and Trademark Office**[Home](#) | [Site Index](#) | [Search](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)**Assignments on the Web > Trademark Query****Trademark Assignment Abstract of Title****Total Assignments: 1****Serial #:** 78201846**Filing Dt:** 01/09/2003**Reg #:** 2844772**Reg. Dt:** 05/25/2004**Registrant:** Network Appliance, Inc.**Mark:** NETAPP**Assignment: 1****Reel/Frame:** 3799/0413**Received:** 06/19/2008**Recorded:** 06/19/2008**Pages:** 7**Conveyance:** CHANGE OF NAME**Assignor:** NETWORK APPLIANCE, INC.**Exec Dt:** 03/10/2008**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** NETAPP, INC.495 EAST JAVA DRIVE
SUNNYVALE, CALIFORNIA 94089**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Correspondent:** MORGAN, LEWIS & BOCKIUS, LLP
ONE MARKET, SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

Search Results as of: 03/13/2012 03:43 PM
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Web interface last modified: Jan 26, 2012 v.2.3.1

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EXHIBIT B

TO NOTICE OF OPPOSITION

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-03-13 15:44:29 ET

Serial Number: 75046018 Assignment Information Trademark Document Retrieval

Registration Number: 2088731

Mark (words only): NETAPP

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2007-08-20

Filing Date: 1996-01-19

Transformed into a National Application: No

Registration Date: 1997-08-19

Register: Principal

Law Office Assigned: LAW OFFICE 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2007-08-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. NETAPP, INC.

Address:

NETAPP, INC.
495 EAST JAVA DRIVE
SUNNYVALE, CA 94089
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

file servers dedicated to perform a single function and dedicated computer hardware and operating software and instructional and user manuals sold therewith

Basis: 1(a)

First Use Date: 1995-09-01

First Use in Commerce Date: 1995-09-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-06-25 - Automatic Update Of Assignment Of Ownership

2007-08-20 - First renewal 10 year

2007-08-20 - Section 8 (10-year) accepted/ Section 9 granted

2007-08-16 - Assigned To Paralegal

2007-07-31 - Combined Section 8 (10-year)/Section 9 filed

2007-07-31 - TEAS Section 8 & 9 Received

2007-03-05 - Case File In TICRS

2003-12-23 - Section 8 (6-year) accepted & Section 15 acknowledged

2003-06-30 - Response received to Post Registration action - Sections 8 & 15

2003-06-30 - PAPER RECEIVED

2003-05-07 - TEAS Change Of Correspondence Received

2003-04-18 - Post Registration action mailed Section 8 & 15

2003-01-21 - Section 8 (6-year) and Section 15 Filed

2003-01-21 - PAPER RECEIVED

1997-08-19 - Registered - Principal Register

1997-05-27 - Published for opposition

1997-04-25 - Notice of publication

1997-03-25 - Approved for Pub - Principal Register (Initial exam)

1997-01-29 - Communication received from applicant

1996-07-29 - Non-final action mailed

1996-07-18 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

ROCHELLE ALPERT

Correspondent

ROCHELLE ALPERT

Morgan, Lewis & Bockius LLP

One Market, Spear Street Tower

San Francisco CA 94105

Phone Number: 415-442-1326

Fax Number: 415-442-1001



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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 2

Serial #: 75046018

Filing Dt: 01/19/1996

Reg #: 2088731

Reg. Dt: 08/19/1997

Registrant: Network Appliance, Inc.

Mark: NETAPP

Assignment: 1

Reel/Frame: 2754/0037

Received: 06/13/2003

Recorded: 06/09/2003

Pages: 12

Conveyance: MERGER

Assignor: NETWORK APPLIANCE, INC.

Exec Dt: 11/01/2001

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: NETWORK APPLIANCE, INC.495 EAST JAVA DRIVE
SUNNYVALE, CALIFORNIA 94089

Correspondent: MORGAN, LEWIS & BOCKIUS LLP

ROCHELLE D. ALPERT
ONE MARKET
SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

Assignment: 2

Reel/Frame: 3799/0413

Received: 06/19/2008

Recorded: 06/19/2008

Pages: 7

Conveyance: CHANGE OF NAME

Assignor: NETWORK APPLIANCE, INC.

Exec Dt: 03/10/2008

Entity Type: CORPORATION

Citizenship: DELAWARE

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: NETAPP, INC.495 EAST JAVA DRIVE
SUNNYVALE, CALIFORNIA 94089

Correspondent: MORGAN, LEWIS & BOCKIUS, LLP

ONE MARKET, SPEAR STREET TOWER
SAN FRANCISCO, CA 94105

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Web interface last modified: Jan 26, 2012 v.2.3.1[HOME](#) | [INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [CONTACT US](#) | [PRIVACY STATEMENT](#)

PROOF OF SERVICE

I declare:

I am and was at the time of the service mentioned in this declaration, employed in the County of San Francisco, California. I am over the age of 18 years and not a party to this cause. My business address is Spear Street Tower, One Market, **San Francisco**, California 94105.

On **March 13, 2012**, I served a copy(ies) of the following document(s)

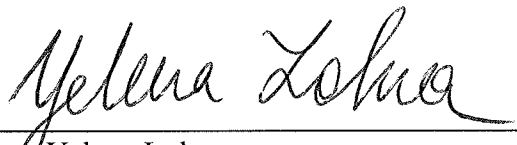
NOTICE OF OPPOSITION (with Exhibits A-B)

by placing them in a sealed envelope(s) addressed as follows:

**ROBERT M. O'CONNELL, JR.
GOODWIN PROCTER LLP
EXCHANGE PLACE 53 STATE ST.
BOSTON, MA 02109**

I placed the sealed envelope(s) for collection and mailing by following the ordinary business practices of Morgan, Lewis & Bockius LLP, **San Francisco**, California. I am readily familiar with Morgan, Lewis & Bockius LLP's practice for collecting and processing of correspondence for mailing with the United States Postal Service, said practice being that, in the ordinary course of business, correspondence (with postage fully prepaid) is deposited with the United States Postal Service the same day as it is placed for collection.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct, and that this declaration was executed on **March 13, 2012**, at San Francisco, California.



Yelena Lolua